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In re Application of:	:	
WIEDERMANN, Ursula, et al.	:	DECISION ON PETITION UNDER
U.S. Application No.: 10/562,064	:	37 CFR 1.47(a)
PCT No.: PCT/EP2004/006519	:	
International Filing Date: 17 June 2004	:	
Priority Date: 23 June 2003	:	
Atty's Docket No.: 37488.00900US	:	
For: PASSIVE IMMUNE THERAPY	:	
AGAINST MALIGNANT	:	
MELANOMA	:	

This decision is issued in response to applicants' "Response to Notice of Missing Requirements and Petition Under 37 CFR 1.47(a)" filed 27 August 2007. Applicants have paid the required petition fee.

**BACKGROUND**

On 17 June 2004, applicants filed international application PCT/EP2004/006519. The international application claimed a priority date of 23 June 2003, and it designated the United States. On 06 January 2005, the International Bureau (IB) communicated a copy of the international application to the United States Patent and Trademark Office (USPTO). The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 23 December 2005.

On 22 December 2005, applicants' filed a Transmittal Letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee and a translation of the international application into English.

On 25 January 2007, the United States Designated/Elected Office (DO/EO/US) mailed a Notification Of Missing Requirement (Form PCT/DO/EO/905) indicating that an executed declaration in compliance with 37 CFR 1.497, the surcharge for filing the oath or declaration later than thirty months after the priority date, and \$180 in additional claims fees were required.

On 27 August 2007, applicants filed a response to the Notification Of Missing Requirements (with required five-month extension fee). The response included payment of the

required surcharge and claims fees, a partially executed declaration, and the petition under 37 CFR 1.47(a) considered herein. The petition seeks acceptance of the application without the signature of inventor Soldano FERRONE, whom applicants assert has refused to execute the application.

### DISCUSSION

A grantable petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17; (2) a statement of the last known address of the non-signing inventor; (3) an oath or declaration executed by the other inventors on behalf of themselves and the non-signing inventor; and (4) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort.

Applicants here have provided the required petition fee, and the petition states the last known address of the non-signing inventor. Items (1) and (2) are therefore satisfied.

Regarding item (3), section 409.03(a) of the Manual of Patent Examining Practice (MPEP) states that:

An oath or declaration signed by all the available joint inventors with the signature block of the nonsigning inventor(s) left blank may be treated as having been signed by all the joint inventors on behalf of the nonsigning inventor(s), unless otherwise indicated.

Here, applicants have filed a declaration executed by the inventors of record in the international application and including an unsigned signature block for the non-signing inventor, Soldano FERRONE. This declaration can be accepted as having been executed by the signing inventors on their own behalf and on behalf of the non-signing inventor. Item (3) is therefore satisfied.

Regarding item (4), MPEP section 409.03(d) states that, before it can be concluded that an inventor has refused to execute the application papers, "[a] copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney." The MPEP also states the following:

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Here, as evidence of the inventor's refusal to execute the declaration, applicants have provided a letter from Robert Schaechter stating that he sent a copy of the declaration to the non-signing inventor, as well as a copy of email communications between Mr. Schaechter and the non-signing inventor. However, as discussed in the MPEP, before it can be concluded that the

inventor has refused to execute the application, applicants are required to provide evidence that a copy of the complete application (specification, claims, and drawings) and a request for signature has been forwarded to the last known address of the inventor. The materials provided here refer only to the declaration being sent to the inventor. In addition, applicants must provide any available documentary evidence to confirm such mailing (i.e., a copy of the cover letter used, a confirmation receipt confirming delivery, etc). In addition, a firsthand statement clarifying the contents of the email correspondence must be provided (it is noted that the emails refer to a refusal to cooperate purportedly made by the inventor in correspondence to a person named "Hubert," but no firsthand information has been provided regarding such refusal).

Until adequate supplemental materials are provided to confirm that a request for signature, accompanied by a copy of the complete application, has been sent to the non-signing inventor's last known address and that the inventor has refused to provide the requested signature in response to such request, item (4) is not satisfied.

### CONCLUSION

Applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of the petition is desired, a proper response must be filed within **TWO (2) MONTHS** of the mail date of the present decision. Any request for reconsideration should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)" and must include the additional materials required to satisfy item (4) of a grantable petition, as discussed above. No additional petition fee is required.

Failure to file a proper response will result in abandonment of the application.  
Extensions of time are available under 37 CFR 1.136(a)

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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